

REMARKS

Claims 1-3, 5-7, 9-11, 13-15, 17-18, 20-21, 23-24, and 26-27 are the claims currently pending the Application. Claim 9 is amended herein.

Claim Objections

Claim 9 is objected to because of informalities. Claim 9 is amended herein to correct these informalities. Applicant requests that this objection be withdrawn.

Rejection of Claims 1-3, 9-11, 17-18 and 23-24 under 35 U.S.C. § 103

Claims 1-3, 9-11, 17-18 and 23-24 are rejected under 35 U.S.C. § 103 as being obvious from Valentine et al., U.S. Patent No. 6,011,973 (“Valentine”), in view Steer, U.S. Patent No. 6,643,517. This rejection should be withdrawn based on the comments and remarks herein.

The Examiner states that Valentine discloses a cellular phone including a memory and a controller and a base station in communication with the cellular phone, but fails to disclose that the controller receives second data which indicates the site of the cellular phone from the base station. The Examiner states that Steer discloses receiving GPS transmissions via broadcast control channels from a base station and determining if the cellular phone is in a protected region. The Examiner further states that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Valentine’s invention to receive GPS transmissions via the base station’s broadcast control channel, and to extend its stop operation to a modem.

In order to establish a *prima facie* case of obviousness, there must be some suggestion or motivation to combine the references. See, *In re Rouffet*, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). The absence of such a suggestion to combine is dispositive in an obviousness determination. See, *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1579 , 42 USPQ2d 1378, 1383 (Fed. Cir. 1997). “The showing of a motivation to combine must be clear and particular, and it must be supported by actual evidence.” *Teleflex, Inc. v. Ficosa North American Corp.*, 299 F.3d 1313, 1334, 63 USPQ2d 1374 (Fed. Cir. 2002) (Citing *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999)). The Examiner provides no actual evidence from Valentine which would motive or suggest to one skilled in the art to add either the feature of receiving data from a broadcast control channel instead of directly from a GPS satellite, or the feature of a modem, to the invention of Valentine. Thus the Examiner has not established a *prima facie* case of obviousness.

Moreover, Valentine teaches GPS which receives transmissions from satellites to determine longitude and latitude coordinates, that is, specific “pin-point” locations (column 2, lines 30-44). In contrast, claims 9 and 23 recite the limitation of a first area being circular and having a radius of about 50M. The determination of whether a cellular phone is located in this first area is made in accordance with the location of the base station with which a cellular phone makes communication. If the base station covers a wide area, the determination of the corresponding first area is made based on data indicative of communication made between the base station and the cellular phone, as well as the location of the base station.

Further, applicant reiterates that neither Valentine nor Steer discloses a modem which modulates signals to be transmitted from said cellular phone and demodulates signals received. Neither Valentine nor Steer disclose a cellular phone having a modem which not only sends and receives signals, but also converts the signals from one form to another for use by both the phone and the base station.

Therefore, even assuming that it would be appropriate to combine these references, their hypothetical combination does not disclose or suggest the cited features of independent claims 1, 9, 17, and 23. Claims 2-3, 10-11, 18, and 24 depend from claims 1, 9, 17, and 23, respectively, and thus incorporate novel and nonobvious features thereof. Therefore, claims 2-3, 10-11, 18, and 24 are patentably distinguishable over the prior art for at least the reasons that their respective base claims are patentably distinguishable over the prior art. Accordingly, this rejection should be withdrawn.

Rejection of Claims 5-7, 13-15, 20-21 and 26-27 under 35 U.S.C. § 103

Claims 5-7, 13-15, 20-21 and 26-27 are rejected under 35 U.S.C. § 103 as being obvious from Steer, U.S. Patent No. 6,643,517. This rejection should be withdrawn based on the comments and remarks herein.

Steer does not disclose or suggest the above-discussed feature of a modem in a cellular phone, as *inter alia* required by independent claims 5, 13, 20 and 26. Further, Steer does not disclose or suggest a circular first area having a predetermine site at its center, as claimed in independent claims 13 and 26. Thus, Steer does not disclose or suggest all of the recited features and limitations of the independent claims.

It has been held by the courts that to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.

See, *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). As illustrated above, Steer does not teach or suggest all features of independent claims 5, 13, 20 and 26. Therefore, Applicant respectfully submits that claims 5, 13, 20 and 26 are patentably distinguished over the cited reference.

Claims 6-7, 14-15, 21 and 27 depend from independent claims 5, 13, 20 and 26, respectively and thus are patentably distinguishable with prior art for at least the reasons that their respective base claims are patentably distinguishable over the prior art. Accordingly, this rejection should be withdrawn.

Conclusion

For at least the reasons set forth in the foregoing discussion, Applicant believes that the Application is now allowable, and respectfully requests that the Examiner reconsider the rejections and allow the Application. Should the Examiner have any questions regarding this Amendment, or regarding the Application generally, the Examiner is invited to telephone the undersigned attorney.

Respectfully submitted,



Katherine R. Vieyra
Registration No. 47,155

Scully, Scott, Murphy & Presser, P.C.
400 Garden City Plaza,
Suite 300
Garden City, New York 11530
(516) 742-4343

KRV: kd